

REMARKS

Claims 1-20 were pending and subject to a restriction requirement. Applicants elected claims 1-13 for prosecution on the merits. The Examiner has withdrawn from consideration, the non-elected claims 14-20, pursuant to the provisions of 37 C.F.R. § 1.142(b). Claims 1-13 were rejected.

Claim 1 has been amended and claims 2 and 3 have been canceled. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment is found in the originally filed claims. Applicants would note that the limitations inserted into claim 1 were originally present in claims 2 and 3. Applicants submit that the present Amendment does not generate any new matter issue.

As to method claims 1-13, it is respectfully submitted that the subject matter of any one group of claims is sufficiently related that a thorough search for the elected subject matter would necessarily encompass a search for the subject matter of the non-elected claims. It is respectfully submitted that the search and examination of the application can be made without serious burden, even though it includes claims to distinct or independent inventions in order to avoid unnecessary delay and expense to Applicants. For these reasons, it is respectfully submitted that the restriction be reconsidered and withdrawn. At the least, re-joinder of the non-elected method claims pursuant to MPEP 821.04 is solicited. Should the examiner make the restriction final and deny rejoinder, Applicants reserve the right to file one or more divisional applications directed to the non-elected subject matter under 35 U.S.C. § 120 and 35 U.S.C. § 121 prior to issuance of any patent granted on the elected subject matter.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated over Meyer et al. (U.S. Pat. No. 5,858,474, collectively "Meyer") or, in the alternative, unpatentable under § 103(a) over Meyer. Applicants respectfully traverse for the reasons set forth *infra*.

Claims 2-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Meyer. The Examiner stated that the limitations of dependent claims 2-13 are conventional and do not render these claims unobvious. Applicants respectfully traverse for the reasons set forth *infra*.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Furthermore, there are significant differences between the claimed invention and the method disclosed by Meyer that would preclude the factual determination that Meyer identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

Specifically, Meyer is silent as to the first and second preselected values of magnetic coercivity (Hc) and magnetic remanence-thickness product (Mrt), as claimed. Meyer, which is discussed in the present specification at page 5, lines 3-10, discloses a magnetic medium

having permanently defined boundaries between data tracks and a constant surface smoothness. The servo-patterns may be formed, at least in part, by a variety of techniques including, *inter alia*, laser ablation, laser heating, photolithography, deposition, ion milling, reverse sputtering, ion implantation, etc., which techniques and can be utilized individually or in combination, with either the magnetic layer or underlayer, to create relatively non-magnetic areas. Applicants submit that claims 1 and 4-13 are free of the applied art for the reasons set forth below.

The Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert, supra*. In the instant case, however, the Examiner has improperly characterized the express limitations of the present claims as "conventional" without identifying where the Meyer reference discloses each claim feature. For this reason alone the rejection over claim 1 is without merit and should be withdrawn.

Moreover, the present invention addresses and solves problems attendant upon the use of ion implantation through apertured masks for forming servo-patterned magnetic recording media without incurring changes or alterations in surface topography, and is based upon the discovery that an improvement in thermal stability and magnetic performance characteristics and parameters can be obtained by performing the ion implantation for servo patterning on magnetic media selected on the basis of having sufficiently high initial values of magnetic coercivity H_c and magnetic remanence-thickness product Mrt , such that the resulting values of H_c and Mrt of the implanted regions forming the servo pattern are low enough to provide adequate sensing for accurate servo-mechanical positioning of a read/write transducer head forming part of a magnetic-based data/information storage and

retrieval system, yet are high enough to afford a requisite or desired degree of media thermal stability, along with desired magnetic performance characteristics/parameters. See page 12, line 26 through page 13, line 11 of the specification.

It is significant to note that Meyer neither identifies nor solves the problem addressed and solved by the present invention. Moreover, and significantly, Appellants solution stems from the recognition of the source of the problems, i.e., there is a reduction or loss of thermal stability and/or signal amplitude that arises during ion implantation of thin film magnetic recording media for servo pattern formation. See specification at page 7, lines 9-15. The discovery of the source of a problem, itself, constitutes an indicium of nonobviousness which merits consideration. *In re Spinnoble*, 405 F.2d 578, 160 USPQ 237 (CCPA 1969).

Further, Applicants submit that Meyer provides no guidance to one of ordinary skill in the art to provide a servo-patterned magnetic recording medium with thermal stability, high amplitude or magnetic transition, and high signal-to-noise ratio, with the method of present claim 1. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants submit that Meyer is void of any such teaching or suggestion, and that one of ordinary skill in the art would not have been motivated to arrive at the claimed invention, without the present disclosure as a template.

It is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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